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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,816	09/18/2003	Susann Marie Keohane	AUS920030442US1	8940

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EXAMINER

DAILEY, THOMAS J

ART UNIT	PAPER NUMBER
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2152

MAIL DATE	DELIVERY MODE
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12/07/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/666,816

Applicant(s)

KEOHANE ET AL.

Examiner

Thomas J. Dailey

Art Unit

2152

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-11, 13-21, 23-31 and 33-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-11, 13-21, 23-31, and 33-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 2, 12, 22, and 32 were cancelled by the amendment filed on October 1, 2007.
2. Claims 1, 3-11, 13-21, 23-31, and 33-40 are pending.

Response to Arguments

3. Applicant's arguments with respect the art rejections directed to claims 1, 7, 11, 17, 21, 27, 31, and 37 have been considered but are moot in view of the new ground(s) of rejection.
4. The applicant neither argued against nor amended to alleviate the 35 USC § 112 2nd paragraph rejections directed at claims 4, 10, 14, 20, 24, 30, 34, and 40 (see paragraph 5 of the Office Action dated April 30, 2007). Therefore these rejections have been maintained.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 4-10, 14-16, 20, 24-26, 30, 34-36, and 40, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point

out and distinctly claim the subject matter which applicant regards as the invention.

7. Claims 4, 10, 14, 20, 24, 30, 34, 40 recite, "the stored email **may be** encrypted by a private key," (e.g. claim 4, lines 1-2). The recitation of "may be" renders the claim indefinite.
8. Claim 7 recites, "the user" (line 20) which lacks antecedent basis in this claim.
9. Claims 5-6, 8-10, 15-16, 25-26, and 35-36 are rejected due to their dependence on the previously rejected claims.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1, 3, 7-9, 11, 13, 17-19, 21, 23, 27-29, 31, 33, and 37-39 are rejected under 35 U.S.C. 103(a) as being unpatentable by Brogne et al (EP Pub. No. 1,087,321), hereafter "Brogne," in view of Milewski et al (US Pat. 5,930,471), hereafter "Milewski."

12. As to claim 1, Brogne discloses a method of rescinding previously transmitted e-mail messages by a sender, the message being addressed to a list of recipients (Abstract), the method comprising the steps of:

storing an e-mail message on a computing system (column 2, lines 13-19);

generating a notification message, the notification message for allowing recipients from the list of recipients to access the e-mail message (column 2, lines 13-19 and column 3, lines 54-57);

sending the notification message to the recipients from the list of recipients (column 2, lines 15-19); and

enabling the sender to preclude one of the recipients from the list of recipients from accessing the stored e-mail message (column 3, lines 32-41).

But, Brogne does not explicitly disclose generating and sending a notification message to the sender and that notification message enabling the preclusion of e-mail access by the receipts. However, Brogne does disclose the sender has access to the e-mail message as long as all recipients have not retrieved it (Fig. 3); Brogne simply does not explicitly state that a notification message gives the sender the means to do so.

However, Milewski discloses generating and sending a notification message to the sender and intended recipients of a message and that notification

message enabling the sender to perform operations on the stored message (column 8, lines 53-64 and column 6, lines 25-33)).

Since both Brogne and Milewski teach methods of accessing previously sent messages by the sender, it would have been obvious to one of ordinary skill in the art at the time of the invention to substitute one method of providing the sender with access to the message with the other thereby achieving the predictable result of enabling the sender to rescind a previously sent message.

13. As to claim 7, Brogne discloses a method of modifying a previously transmitted e-mail message by a sender, the message being addressed to a list of recipients (Abstract), the method comprising the steps of:

storing the e-mail message on a computing system (column 2, lines 13-19);

generating a notification message, the notification message for allowing recipients from the list of recipients and the sender access the stored e-mail message (column 2, lines 13-19 and column 3, lines 54-57);

sending the notification message to the recipients from the list of recipients (column 2, lines 15-19); and

enabling the sender to modify the stored e-mail message (column 3, lines 32-41), including:

determining whether at least one recipient from the list of recipients has already accessed the stored e-mail message (column 5, lines 52-54 and

column 6, lines 7-9, the status storage keeps track of how many recipients have accessed the message);

allowing the sender to modify the displayed copy of the stored e-mail message and to send the modified copy to the recipients that have not already accessed the stored e-mail message (column 6, lines 7-19); and

replacing the stored e-mail message with the modified copy once the modified copy is sent to the recipients that have not already accessed the stored e-mail message (column 6, lines 7-19).

But, Brogne does not explicitly disclose generating and sending a notification message to the sender and that notification message enabling the modification of a previously sent message. However, Brogne does disclose the sender has access to and can modify the e-mail message as long as all recipients have not retrieved it (Fig. 3); Brogne simply does not explicitly state that a notification message gives the sender the means to do so.

Further, Brogne is silent with regards to displaying the list of recipients and a copy of the stored e-mail message to the user wherein all recipients from the list of recipients that are determined to have already accessed the stored e-mail message are displayed in a distinguishing fashion from recipients that have not already accessed the stored e-mail message.

However, Milewski discloses generating and sending a notification message to the sender and intended recipients of a message and that notification message enabling the sender to perform operations on the stored message (column 8, lines 53-64 and column 6, lines 25-33)) and further displaying the list of recipients and a copy of the stored e-mail message to the sender wherein all recipients from the list of recipients that are determined to have already accessed the stored e-mail message are displayed in a distinguishing fashion from recipients that have not already accessed the stored e-mail message (Fig. 6 and column 8, lines 9-24).

Since both Brogne and Milewski teach methods of accessing previously sent messages by the sender, it would have been obvious to one of ordinary skill in the art at the time of the invention to substitute one method of providing the sender with access to the message, including Milewski's notification of what recipients have accessed the message, with the other thereby achieving the predictable result of enabling the sender to modify a previously sent message and giving the sender more information with regard to the previously sent message (i.e. what recipients have or have not accessed the message).

14. As to claims 11, 21, and 31, they are rejected by the same rationale set forth in claim 1's rejection.

15. As to claims 17, 27, and 37, they are rejected by the same rationale set forth in claim 7's rejection.
16. As to claims 3, 8, 13, 18, 23, 28, 33, and 38, Brogne and Milewski disclose the invention substantially with regard to the parent claim, and further disclose discloses the e-mail message having a text portion, the sender being allowed to modify the text portion (Brogne, column 3, lines 39-41).
17. As to claims 9, 19, 29, and 39 Brogne and Milewski disclose the invention substantially with regard to the parent claim, and further disclose discloses the e-mail message has a list of recipients, the list of recipients being modified by the sender (Brogne, column 3, lines 32-41).
18. Claims 4-6, 10, 14-16, 20, 24-26, 30, 34-36, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brogne and Milewski as applied to claims 1, 7, 11, 17, 21, 27, 31, and 37 above, and further in view of what is well known in the art.
19. As to claim 4, 10, 14, 20, 24, 30, 34, and 40, Brogne and Milewski disclose the invention substantially with regard to the parent claim, and further disclose the notification message for automatically accessing the e-mail message being a password (Brogne, column 5, lines 21-24).

Although, Brogne does not explicitly disclose that the password is a public key which decrypts the stored email, Official Notice is taken (MPEP 2144.04) that encrypting emails using a public key password was a well-known use of email access passwords at the time the applicant's invention was made, and is deployed to enhance security of the stored emails. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to take advantage of a well known practice to modify the teachings of Brogne and Milewski in order to achieve such benefits.

20. As to claims 5, 15, 25, and 35, Brogne and Milewski disclose the invention substantially with regard to the parent claims 4, 14, 24, and 34, and further disclose the computing system is the computing system on which the stored e-mail message was composed (Brogne, column 4, lines 12-26).

21. As to claims 6, 16, 26, and 36, Brogne and Milewski disclose the invention substantially with regard to the parent claims 4, 14, 24, and 34, and further disclose the computing system is a server, the server generating and sending the notification message to the recipients and sender (Brogne, column 2, lines 12-19).

Conclusion

22. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
23. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.
24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Dailey whose telephone number is 571-270-1246. The examiner can normally be reached on Monday thru Friday; 9:00am - 5:00pm.
25. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571-272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

26. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


TJD
12/5/2007


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SUPERVISORY PATENT EXAMINER

12/6/7